

REMARKS

Claims 51-88 are pending and have been restricted under 35 U.S.C. § 121 into the following groups:

Group I: Claims 51-54 and 58-63, drawn in part to a method for determining the risk of tumor recurrence or spread in a patient suffering from prostate cancer, said method comprising determining a BAG gene expression level, wherein the BAG gene expression level is determined by measuring a BAG protein level;

Group II: Claims 51, 52, 55-60 and 63, drawn in part to a method for determining the risk of tumor recurrence or spread in a patient suffering from prostate cancer, said method comprising determining a BAG gene expression level, wherein the BAG gene expression level is determined by measuring the level of a nucleic acid which encodes said BAG protein;

Group III: Claims 64-68 and 72-77, drawn in part to a method for determining a prognosis of survival in a patient suffering from prostate cancer, said method comprising determining a BAG gene expression level, wherein the BAG gene expression level is determined by measuring a BAG protein level;

Group IV: Claims 64-66, 69-74 and 77, drawn in part to a method for determining a prognosis of survival in a patient suffering from prostate cancer, said method comprising determining a BAG gene expression level, wherein the BAG gene expression level is determined by measuring the level of a nucleic acid which encodes said BAG protein;

Group V: Claims 78-80 and 84-88, drawn in part to a method for monitoring the effectiveness of a course of treatment for a patient suffering from prostate cancer, said method comprising determining a BAG gene expression level, wherein the BAG gene expression level is determined by measuring a BAG protein level; and

Group VI: Claims 78 and 81-86, drawn in part to a method for monitoring the effectiveness of a course of treatment for a patient suffering from prostate cancer, said method comprising determining a BAG gene expression level, wherein the BAG gene expression level is determined by measuring the level of a nucleic acid which encodes said BAG protein.

The Examiner requests that one of the groups of claims be elected for examination. Although the restriction requirement is traversed for the reasons set forth below, Applicants elect the claims of Group I, claims 51-54 and 58-63, for examination.

The Restriction Requirement is traversed with respect to the division of the claims of Group I from the claims of Group III and V. While the claims of Groups I, III and V are patentably distinct, it is submitted that a thorough search of the claims of any of these groups will likely reveal art relevant to the examination of the claims of the other group. In particular, the claims of Groups I, III and V are directed to methods that include determining BAG gene expression levels by measuring BAG protein level. Thus, a search of the claims of Group I will, of necessity, reveal information relevant to the examination of the claims of Groups III and V and, therefore, division of the claims into these groups would result in duplicative searches. Therefore, examination of the claims of Group I with the claims of Groups III and V together should not be an undue burden on the Examiner.

The Examiner has additionally requested that a species election be made. Applicants elect the species of BAG-1. The claims readable on the elected species include claims 51-54 and 58-63 of Group I, claims 64-68 and 72-77 of Group III, and claims 78-80 and 84-88 of Group V.

Applicants elect the claims of Group I, claims 51-54 and 58-63, for examination. Applicants further elect the species of BAG-1. Applicants respectfully request that the Restriction Requirement be reconsidered and that the claims of Group I be examined with the claims of Groups III and V. The Examiner is invited to call the undersigned agent if there are any questions.

10/030,497

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Deborah L. Cadena

Registration No. 44,048

4370 La Jolla Village Drive, Suite 700
San Diego, CA 92122
Phone: 858.535.9001 DLC:llf
Facsimile: 858.597.1585
Date: September 23, 2005

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as our correspondence address.**